

REMARKS

The August 1, 2006 final Office Action regarding the above-identified application has been carefully considered; and the claim amendments above together with the remarks that follow are presented in a bona fide effort to respond thereto and address all issues raised in that Action. For reasons discussed below, it is believed that this case is in condition for allowance. Prompt favorable reconsideration of this amended application is requested.

It is proposed above to amend claims 11 and 13 to add “for” after “service center”. Minor clarifying amendments have been made in dependent claims 32 and 33. The amendments to the claims may help to address an indefiniteness issue raised in the Action. However, the amendments should not alter claim scope. In view of the minor revisions to the claims, the amendments above should not introduce new subject matter or present any issue requiring further search or consideration at this stage of prosecution. It is therefore believed that entry of the amendments to the claims is proper under Rule 116.

Written Statement of the Substance of a Telephone Interview

The courtesy extended by Examiner Carlson in the telephone interview with the undersigned conducted on October 20, 2006 is appreciated. Independent claims 11, 13, 15 and 17 were discussed, in the form presented in the listing above. The art documents cited in the latest art rejection, specifically U.S. Patent No. 5,287,181 to Holman, U.S. Patent No. 4,674,041 to Lemon et al. (Lemon) and U.S. Patent No. 6,282,713 to Kitsukawa et al. (Kitsukawa), were discussed in comparison to those independent claims.

Applicants’ representative pointed out that the claims relate to broadcasting or transmitting coupon information together with a program or commercial message, sending a request based on that information to the broadcasting/transmitting unit or to a service center,

issuing a coupon in response to that request, and counting issuance of the coupon in relation to a program or commercial message with which information about the coupon was initially distributed. Applicants' representative then asserted that the combination of steps or functions recited in claims 11, 13, 15 and 17 was not taught by the applied patents. In both Holman and Kitsukawa, the receiver in the home receives coupon related data with the video program and the receiver captures selected coupon information in response to user activation, without sending a request upstream and without a further transmission/issuance of the coupon from an upstream unit such as the service center or the broadcasting or transmitting unit. In Holman, attention is directed to column 6, lines 24-60. In Kitsukawa attention is directed to FIG. 8 and the discussion thereof in columns 10 and 11, particularly column 11, lines 38-47. Lemon teaches monitoring and limiting coupon issuances (column 4, lines 47-55), but the issuing terminal only reports issuances to the host after every seventh transaction is completed (column 7, lines 25-30). As such, Lemon does not suggest use of information received with a program or commercial to send a coupon request to the host or subsequent transmission of the coupon in response to receipt of the request at the host. Any combination of the Holman, Lemon and Kitsukawa would allow the terminal or receiver device to issue the coupon without sending a request upstream and without a responsive coupon issuance or transmission from the upstream unit.

The Examiner acknowledged the asserted distinction of claims 11, 13, 15 and 17 over the applied art and indicated that he would reconsider the rejection upon receipt of a formal response.

Response to Office Action

The final Office Action included an objection to the prior amendment which introduced claims 32 and 33, under 35 U.S.C. § 132 on the ground that those claims were directed to new

matter. The objection asserted that the application disclosure of the program guide does not specifically teach that the guide provides the identifier for attachment to the coupon issuance request. This objection is respectfully traversed.

Dependent claims 32 and 33 recite that the information attaching means obtains the information about the program or commercial message, for attachment to the shopping coupon issuance request, by referring to an electronic program guide. As disclosed in the original application, the information for identifying the program is an identifier of a broadcast. Examples of such identifiers include “program name” and “broadcasting data and time (time zone)”. See page 12, lines 7 to 11, of the original specification. The specification also characterizes the program name as an identifier for identifying the program, in lines 24 to 25 of page 13. The “program name” and “broadcasting data and time” are displayed and may be added to the coupon issuance request. See page 12, lines 11 to 16, of the original specification. A function of the receiver is to receive a broadcast schedule in the form of a program guide. See page 11, lines 13 to 15, of the original specification. Those skilled in the art would recognize that “program name” and “broadcasting data and time” are pieces of information commonly provided by the received electronic program guide. The “broadcasting schedule to be broadcasted by the data broadcasting” (page 11, lines 14-15) thus provides the “program name” and “broadcasting data and time”, which the original description said could be added to the coupon issuance request (page 12, lines 7 to 16). The specification states that the information relating to the program or commercial message (FIG. 2A) is added to the coupon issuance request in the receiver 31 upon transmission of the coupon issuance request (see e.g. page 13, lines 1-4). Applicants therefore submit that the disclosure on pages 11-13 provides a written description of obtaining the information about the program or commercial message, for attachment to the shopping coupon

issuance request as the information about the program or commercial message, by referring to an electronic program guide, as recited in claims 32 and 33. Hence, the new matter objection is improper and should be withdrawn.

The final Office Action included a rejection of claims 11, 13, 15, 17, 20,21 and 23-33 under 35 U.S.C. § 112 second paragraph for alleged indefiniteness. The claims include various functional recitations, such as “for broadcasting or transmitting,” “for receiving” and/or “for managing.” However, such recitations do not specify method steps, as asserted in this rejection. Functional recitations are not inherently indefinite. In this case, the functional claim language is believed to be quite clear and concise. Hence, the pending claims should be free of indefiniteness, and the indefiniteness rejection should be withdrawn.

The final Office Action raised only one other issue, in the form of a rejection of claims 11, 13, 15, 17, 20, 21 and 23-33 under 35 U.S.C. § 103 as unpatentable over the a combination of Holman, Lemon et al. (hereinafter Lemon) and Kitsukawa et al. (hereinafter Kitsukawa). This rejection is traversed on the ground that those patents together do not actually disclose one or more features recited in each of Applicants’ independent claims.

Each of the claims in this case relates to a system. In all of the independent claims, the system includes a broadcasting or transmitting unit and a receiver. In claims 11 and 13, the system also includes a service center.

The technology disclosed in this application involves broadcasting or transmitting coupon information for use in requesting issuance of a shopping coupon together with a program or a commercial message. Each independent claim includes a recitation to this effect. The receiver, however, sends a request for requesting issuance of a shopping coupon, and the service center or the broadcasting or transmitting unit transmits or issues the coupon in response to receipt of such

a request via a network. Each independent claim includes recitations on these points as well. Hence, every independent claim requires that the communication of the program or commercial message have associated coupon information for use in requesting issuance of a shopping coupon, the receiver sends a request based on that coupon information back to the service center or the broadcasting or transmitting unit, and the service center or the broadcasting or transmitting unit issues the coupon or transmits the coupon to the receiver in response to receipt of the request via a network. The applied documents by Holman, Lemon and Kitsukawa do not disclose the claimed means for implementing these request communication and coupon issuance functions.

In both Holman and Kitsukawa, the receiver in the home receives coupon related data with the video program and the receiver captures selected coupon information in response to user activation, without sending a request upstream and without a further transmission/issuance of the coupon from an upstream unit such as a service center or the broadcasting or transmitting unit. In Holman, attention is directed to column 6, lines 24-60. In Kitsukawa attention is directed to FIG. 8 and the discussion thereof in columns 10 and 11, particularly column 11, lines 38-47. Lemon teaches monitoring and limiting coupon issuances (column 4, lines 47-55), but the issuing terminal only reports issuances to the host after every seventh transaction is completed (column 7, lines 25-30). As such, Lemon does not suggest use of information received with a program or commercial message to send a coupon request to Lemon's host or subsequent transmission of the coupon in response to receipt of the request at the host. Any combination of the Holman, Lemon and Kitsukawa would allow the terminal or receiver device to issue the coupon without sending a request upstream and without a responsive coupon issuance or transmission from the upstream unit.

Because the Holman, Lemon and Kitsukawa documents do not suggest communication of the request message from the receiver back to the service center or the broadcasting or transmitting unit, the combination of those documents fails to meet a number of additional requirements of the independent claims. For example, none of the applied documents fairly suggests attaching the program or commercial identifier to the request message sent to the service center or the broadcasting or transmitting unit, therefore the art does not include the information attaching means recited in any of Applicants' independent claims.

Since the combination of the Holman, Lemon and Kitsukawa documents does not satisfy all of the requirements of any one of the independent claims, all of the pending claims should be patentable over that applied art. The rejection for alleged lack of patentability over those documents should be withdrawn.

Conclusions

Upon entry of the above claim amendments, claims 11, 13, 15, 17, 20, 21 and 23-33 remain active in this application, all of which should be supported by the original application disclosure, definite and patentable over the art applied in the Action. Accordingly, this case should now be ready to pass to issue; and Applicants respectfully request a prompt favorable reconsideration of this matter.

It is believed that this response addresses all issues raised in the August 1, 2006 final Office Action. However, if any further issue should arise that may be addressed in a further interview or by an Examiner's amendment, it is requested that the Examiner telephone Applicants' representative at the number shown below.

To the extent necessary, if any, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of

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this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

A handwritten signature in black ink, appearing to read "Keith E. George".

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